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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,653	10/10/2001	Andrew D. Bicek	760-49	9912

7590

01/10/2006

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,653

Applicant(s)

BICEK ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 25-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Pre-Appeal Brief filed 10/7/2005, with respect to claims 17-24 and 39 are acknowledged. Therefore, the Final Office Action has been withdrawn. However, upon further consideration, the above noted references in view of Von Oepen et al (5,916,264) and Love (5,865,723) are still considered to read on the claimed limitations of the claims noted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, it is unclear from the specification and drawings, how a sheath is disposed radially outwardly of a main stent. While claim 20 recites, "wherein said sheath is disposed radially inwardly of said main stent". Clarification is requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-18,21-24 and 39 are rejected under 35 U.S.C. 102 (b) as being anticipated by Von Oepen et al (U.S. 5,916,264).

Regarding claims 17 and 39, Von Oepen et al disclose in fig 1, a stent graft for insertion into target site within a vessel of a patient, including: a main stent (11) has a radially-expandable body, at least one support stent (12), and a sheath (13) interpose between the body, and the support stent where no portions of the main stent is in contact with the support stent, and the sheath is not bonded to the main stent. Note that the support stent in fig. 1 can generate a force with the main stent to hold the sheath in place

Regarding claims 18-19, Von Oepen et al disclose the support stent (12) is capable of plastically deformed (see col.1, lines 33-36 and lines 51-67). The sheath (13) disposes radially outwardly of the main stent.

Regarding claims 21-22, Von Oepen et al disclose the support stent (12) has an axial length which is less than the axial length of the body.

Regarding claims 23-24, Von Oepen et al disclose sheath is selected from the group consisting of a polymeric/a biomaterial sleeve (see col.2, lines 21-24 and lines 30-35). The sheath is also treated with a drug selected from the group consisting of bioactive agents (see col.1, lines 59-61).

Claims 17 and 39 are rejected under 35 U.S.C. 102 (b) as being anticipated by Love (U.S.5,865,723).

Regarding claims 17 and 39, Love discloses in figures 1-2, a stent graft for insertion into target site within a vessel of a patient, including: a main stent (10) has a radially-expandable body, at least one support stent (14), and a sheath (12) interpose between the body, and the support stent where no portions of the main stent is in contact with the support stent, and the

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sheath is not bonded to the main stent. Note that the support stent in fig. 1 can generate a force with the main stent to hold the sheath in place.

Response to Arguments

4. Applicant's arguments filed 10/7/2005 have been fully considered but are moot in view of new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above where examiner addresses applicant's concerns regarding prior art rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn *Vn*
1/6/2006

Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER